

REMARKS**Summary of the Office Action**

Claims 25 and 26 stand rejected under 35 U.S.C. § 101 as allegedly “being directed to non-statutory subject matter.”

Claims 1, 3, 4, 6, 8, 10, 11, 13, 14, 16, 17, 19, 21, 22 and 24-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Itoh et al. (U.S. Patent No. 6,700,989) (hereinafter “Itoh”).

Claims 7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Itoh.

Claims 2, 5, 12, 15, 18, 20 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Itoh as applied to claims above, and further in view of Kikuchi et al. (U.S. Patent No. 6,577,811) (hereinafter “Kikuchi”).

Summary of the Response to the Office Action

Applicants have amended claims 1, 4-6, 11, 14-20 and 22-26, and added new claims 27-40, to differently describe the embodiments of the disclosure of the instant application’s specification and/or to improve the form of the claims. Accordingly, claims 1-40 are currently pending for consideration.

Rejections under 35 U.S.C. § 101

Claims 25 and 26 stand rejected under 35 U.S.C. § 101 at page 2, paragraphs 1-2 of the Office Action as allegedly “being directed to non-statutory subject matter.” The only explanation for this rejection in the Office Action is that “the claims recite ‘A computer signal

embodied in a carrier wave and representing a series of instructions...’ The Examiner then alleges, in a conclusory fashion, that “[t]his recitation is non-statutory.” Applicants respectfully traverse this rejection for at least the following reasons.

Applicants respectfully submit that the format of claims 25 and 26, each recite a computer data signal embodied in a carrier wave and representing a series of instructions which cause a computer to perform steps to execute a recording control process in an information recording apparatus. Accordingly, such a format is standard and is fully compliant with the directives of the Examination Guidelines for Computer-Related Inventions, as set forth in MPEP § 2106.

For example, MPEP § 2106 IV.B.1 discusses “functional descriptive material” that “consists of data structures and computer programs which impart functionality when employed as a computer component.” The portion of the MPEP goes on to explain that “[w]hen functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since the use of technology permits the function of the descriptive material to be realized.” See In re Lowry, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994) and In re Warmerdam, 33 F.3d 1354, 1360-61 (Fed. Cir. 1994).

Even further, MPEP § 2106 IV.B.1(a) goes on to direct that “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory. Accordingly, claims 25 and 26 are fully consistent with these specific MPEP directives.

Applicants refer to the foregoing discussion of the directives of the Examination Guidelines for Computer-Related Inventions, as set forth in MPEP § 2106 in this regard. For example, this section teaches that a claimed process must have a practical application that produces a “useful, concrete, and tangible result” to be considered statutory. In particular, at MPEP § 2106. II. A., the MPEP directs that

“Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101 (emphasis added).”

Even further, Applicants respectfully submit that there is no specific explanation of the basis of this rejection in the Office Action. Accordingly, Applicants respectfully submit that this form of rejection is improper and should be withdrawn. In the event that this rejection might be repeated in a further Office Communication, it is respectfully requested that full details supporting the basis of this rejection be supplied.

By the Office Action’s lack of providing any explanation of the basis for its rejection under 35 U.S.C. § 101, it is clear that such a *prima facie* case has not been made. Nevertheless, Applicants respectfully submit that the formats of claims 25 and 26 are fully compliant with the above-discussed portions of the MPEP. As a result, withdrawal of the rejections of claims 25 and 26 under 35 U.S.C. § 101 is respectfully requested.

Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1, 3, 4, 6, 8, 10, 11, 13, 14, 16, 17, 19, 21, 22 and 24-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Itoh. Claims 7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Itoh. Claims 2, 5, 12, 15, 18, 20 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Itoh as applied to claims above, and further in view of Kikuchi. Applicants have amended claims 1, 4-6, 11, 14-20 and 22-26 to differently describe embodiments of the disclosure of the instant application's specification and/or to improve the form of the claims. To the extent that these rejections might be deemed to apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

At page 3 of the Office Action, the Examiner states that Itoh discloses the “device and process for recording in the recording medium front part record information that is the record information before the specified division timing and rear part record information that is the record information after the specified division timing.” In this regard, the Office Action refers to col. 31, lines 15-16 of Itoh “the moving image is stored by the computer, and that resulting data file is transferred or duplicated (emphasis added).”

However, Applicants respectfully submit that the specified division timing of embodiments of the disclosure of the instant application is a timing to divide continuous record information into two or more items of part information. In order to clarify this important feature of the instant application's disclosure, independent claim 1 has been amended in this regard. As a result, the continuous record information is divided into front part record information before the specified division timing and rear part record information after the specified division timing. Applicants respectfully submit that it is important to note that the contents of the front part

record information and the rear part record information in embodiments of the disclosure of the instant application are different from each other.

On the other hand, Applicants respectfully submits that Itoh merely discloses that the resulting data file is transferred or duplicated. If the data file is transferred from a source to a destination, there is no data file in the source. The contents of the transferred data file must be the same as an original one recorded in the source. Further, if the data file is duplicated, an exact copy of the data file is made. Applicants respectfully submit that it is well understood that the word "duplicate" means to "make an exact copy."

Accordingly, Applicants respectfully submit that the transferring and duplicating operations described in Itoh are totally different from the dividing operation described in newly-amended independent claim 1 of the instant application.

Applicants respectfully submit that similar arguments apply to the remaining independent claims of this application. In particular, Itoh does not disclose, or even suggest, the device and process for recording in the recording medium: (1) front part record information that is the record information before the specified division timing, and (2) rear part record information that is the record information after the specified division timing.

Applicants respectfully submit that similar arguments can be applied to the remaining features pointed out by the Examiner. For example, the device and process for specifying a division timing in the recording information, the device and process for generating permission information, and the device and process for recording the generated permission information are not disclosed, or even suggested, in Itoh to any extent. Moreover, Applicants respectfully submit

that the permission information described in the instant application's claims is entirely different from the copy restriction information of Itoh.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. § 102(b) should be withdrawn because Itoh does not teach or suggest each feature of the independent claims of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Furthermore, Applicants respectfully assert that the dependent claims are allowable at least because of their dependence from particular independent claims of the instant application, and the reasons set forth above. In addition, with regard to the rejections under 35 U.S.C. § 103(a), these rejections should also be withdrawn because the additionally applied reference to Kikuchi does not cure the deficiencies of Itoh discussed above with regard to the independent claims of the instant application.

Applicants have added new claims 27-40 to differently describe embodiments of the disclosure of the instant application. Applicants respectfully submit that similar arguments for patentability as discussed above also apply to these newly-added claims.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this

response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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